

FALK & FISH

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L. Spruell

January 19, 2001

VIA FACSIMILE - (703) 308-5841

Examiner Stephen Funk
United States Patent and Trademark
Office Group 2854
Room 9D35- Crystal Plaza IV
Arlington, VA 22202

Re: Reissue Application Serial No. 09/315,796 to Davis and Williamson
Our File: WILL 2501

Dear Examiner Funk:

All parties have executed a proposed agreed judgment concerning the pending litigation in the Northern District of Texas which Judge Barbara Lynn is expected to sign next Monday or Tuesday (she is currently out of chambers). Plaintiffs in the litigation/protestors here have conceded priority and inventorship.

A formal paper attaching a copy of the executed judgment will be transmitted to you when we receive it early next week.

In the meantime, reissue applicants are preparing several (probably 4) papers to be filed to complete the record in this reissue proceeding. Because of the time delay in the clerk's office, these papers will be sent to you directly. The protest is expected to be withdrawn.

Respectfully submitted,



Robert Hardy Falk

RHF:tsmc
Enclosure(s)

cc: John P. Pinkerton, Esq.

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[illegible]

6. Defendant Jesse S. Williamson ("Williamson") is an individual who resides in Dallas, Texas.

7. For the purpose of this action, this Court has personal jurisdiction of PRI, DeMoore, Rendleman, WPC, Davis and Williamson.

8. This Court has subject matter jurisdiction pursuant to 28 U.S.C. §§ 1338 and 1367.

9. WPC is the owner of United States Patent No. 5,630,363 ("the '363 patent"). On May 20, 1999, WPC filed application serial number 09/315,796 in the United States Patent and Trademark Office ("PTO") to reissue the '363 patent ("the Reissue Application"), which is presently pending in the PTO.

10. The uncontroverted evidence in the record shows that, in June of 1992, Davis and Williamson conceived the invention described and claimed in the '363 patent.

11. The evidence in the record further shows that, on June 12, 1994, Davis and Williamson disclosed the invention of the '363 patent to Steve Baker ("Baker"), a salesman of PRI, telling him that they wanted to apply inks or coatings using the flexographic process upstream of or prior to printing with lithography in a continuous in-line process on an offset lithographic press and that they wanted to use a retractable, interstation printer/coater having an anilox roller and chambered doctor to perform the flexographic process, and that on June 15, 1994, Baker told John W. Bird ("Bird"), product manager of PRI, the information that Davis and Williamson had disclosed to Baker on June 12, 1994.

12. WPC entered into an agreement with PRI to provide to WPC a retractable, interstation flexographic printer/coater with an anilox roller and a chambered doctor.

13. Pursuant to DeMoore's request on July 7, 1994, Rendleman, who was employed by PRI, prepared drawings of the ferris wheel, retractable flexographic printer/coater shown in Figure 2 of the '363 patent. The ferris wheel, retractable flexographic printer/coaters

manufactured and delivered to WPC by PRI were paid for by WPC pursuant to the agreement between WPC and PRI.

14. On May 4, 1995, DeMoore, Rendleman and Bird filed U. S. patent application serial number 08/435,798 ("the '798 application"). The overlapping process disclosure common to the '798 application and the '363 patent and the Reissue Application originated from Davis and Williamson. The subject matter of unprosecuted method claims 24-35 of the '798 application, and narrower claims thereof, do not conflict with the '363 patent and the Reissue Application. Davis, Williamson and WPC do not claim inventorship of the claimed subject matter of claims 1-23 of the '798 application pending (allowed or on appeal) as of December 1, 2000, and the unprosecuted claims 24-35 of the '798 application, and any claims of U.S. Patents No. 5,598,777, No. 5,631,316, No. 5,960,713, and No. 6,116,158.

15. Plaintiffs no longer contend that they, individually, collectively or in any combination, is or are a sole or joint inventor of any claim of the '363 patent as issued or any of claims 1-87 of the Reissue Application pending as of December 1, 2000.

16. With respect to all claims of the '363 patent as issued and claims 1-87 of the Reissue Application pending as of December 1, 2000, priority rests in the inventive entity of Davis and Williamson and not in any entity consisting of one or more of DeMoore, Rendleman and Bird.

17. There was no fraud or inequitable conduct in the prosecution of the application that resulted in issuance of the '363 patent.

18. Based on the evidence in the record in this action, the information presently known to the parties, and the prior art and other information of record in the Reissue Application, all claims of the '363 patent as issued, and claims 1-87 of the Reissue Application, are valid, including being valid under the provisions of 35 U.S.C. §§ 102 (a), (b), (c), (e), (f) and (g) and 103.

19. Apart from the specific findings set forth herein, all claims and counterclaims of the parties in this action are hereby dismissed with prejudice.

20. The parties waive all right to appeal from this judgment.

21. Each party shall pay its own attorney's fees and costs.

22. This Court shall retain jurisdiction to enforce this judgment and the settlement agreement entered into by the parties with respect to this action.

SO ORDERED on this ____ day of January, 2001.

BARBARA M.G. LYNN
UNITED STATES DISTRICT JUDGE

APPROVED AND AGREED TO
AS TO FORM AND CONTENT:

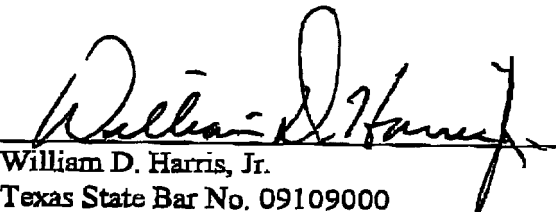
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Its: President

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